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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,026	08/26/2003	Liqin Sun	17596-1	3490

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EXAMINER

VAKILI, ZOHREH

ART UNIT PAPER NUMBER

1614

MAIL DATE DELIVERY MODE

07/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/648,026

Applicant(s)

SUN, LIQIN

Examiner

Zohreh Vakili

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-6,12,14,17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,12,14,17,19-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

**Claims 1-2, 4-6, 12, 14, 17, and 19-20 are presented for examination.**

Applicant's Amendment filed April 26, 2007 has been received and entered into the present application. Accordingly, claims 1-5 are currently amended. Claim 6 is newly added. Claims 1-2, 4-6, 12, 14, 17, and 19-20 are pending and are herein examined on the merits.

Applicant's arguments, filed April 26, 2007, have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

#### ***Response to Declaration under C.F.R. §1.132***

Applicant's Declaration of Jing Tang Liu submitted under 37 C.F.R. 1.132 filed April 26, 2007 has been received and entered into the application.

In view of the amendments and remarks made herein, the rejection of claims 1-6, 12-14, and 17 under 35 U.S.C 102(b) and 35 U.S.C. 103(a) have been hereby withdrawn.

Applicant's Declaration of Liqin Sun, submitted under 37 C.F.R. 1.132 filed April 26, 2007 has been received and entered into the application. However, an

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affidavit cannot overcome a 102 rejection where the product and its use was known before the Applicant's filing date.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 4-6, 12, 14, 17, and 19-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Oculax<sup>TM</sup>, copyright 3T Herbtech Inc. 2000.

The instantly claimed invention is apparently the commercial product Oculax<sup>TM</sup> as described on page 6 of the instant specification and that the website printout is reasonable evidence that the invention was known in this country before the invention thereof by the applicant for a patent. Please see page 2 of the website printout it indicates since January to November of 2002, Oculax has been clinically experimented by 3T Manufacturing (USA) Inc.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6, 12, 14, 17, and 19-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oculax™ (<http://www.3t-herb.com/html/oculax.html>, Copyright 2000) and in view of Konishi (US Patent No. 4858604).

Oculax™ an acupoint patch for eye relaxing made from the extracts of Ligusticum, Salvia root, Tangkuei, and Chrysanthemum for the treatment of trachoma, myopia, presbyopia, cataract, and glaucoma (see page 1).

Konishi in its invention teach an adhesive bandage comprising a pad for absorbing a medicine which is separately stored from the pad by means of a medicine covering film interposed between the medicine and the adhesive tape or by means of a capsule enclosing the medicine in it until the bandage is applied to a local site of body such as wound, an adhesive tape carrying the pad thereon, a release sheet provided with a blister portion adapted to placing the medicine in it and attached to the adhesive tape in such a manner that the open side of the blister may face the adhesive tape (see abstract). Konishi further teaches the invention comprises an adhesive tape carrying a pad, and a medicine enclosed in a space defined between a medicine covering film and a blister formed on a release sheet. The release sheet may be provided at one end with a slit along which the release sheet may be bent so that it may be easily removed. An appropriate quantity of the medicine is put into a blister formed at a predetermined position of the release sheet and the recess is sealed with the medicine covering film by

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the press trough pack method. Then, the release sheet is attached to the adhesive tape carrying a pad (see column 2, lines 23-41).

Clearly, the skilled artisan is provided with ample instruction and motivation to use the ingredients provided by Oculax for an eye patch along with the teachings of Konishi discloses a transdermal patch for releasing various kinds of medicines, a sterilizer, an anti-inflammatory agent, an anti-histamine. The patch consists of the adhesive tape, the pad, the release sheet, the blister for medicine storage, and when the bandage is to be applied to a wound, a finger pressure is applied to the blister to rupture the medicine covering film to cause the medicine to flow onto the pad. The skilled artisan is motivated to make compositions of the well known ingredients known for treating trachoma, myopia, cataract, etc. incorporated in a transdermal patch taught by Konishi. Thus, one of ordinary skill in the art would have been motivated to combine the teachings of the above references and as combined teach the invention as claimed.

Where the claimed and prior arts ingredients of a composition are identical a prima facie case of obviousness has been established. Thus the claimed invention was within the ordinary skill in the art to make and use at the time the claimed invention was made and as a whole, prima facie obvious.

### ***Response to Argument***

Applicant argues that Konishi does not teach of a patch that comprises of the calimed ingredients. Konishi teaches of a transdermal patch that can release medicine

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to a patient and in combination with the teachings by Oculax an eye patch the present invention is prima facie obvious. Applicant has amended claim 17 by changing the names of the ingredients from their common names to their genus and species names. For example, Angelica sinensis filtrate is commonly known as Tangkuei extract and Salvia is commonly referred to the root of Salvia miltiorrhiza. Applicant's amendments and remarks have been carefully considered in their entirety, but fail to be persuasive in establishing error in the propriety of the present rejection.

#### **Conclusion**

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Vakili whose telephone number is 571-272-3099. The examiner can normally be reached on 8:30-5:00 Mon.-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zohreh Vakili  
Patent Examiner  
1614/TC 1600

July 3, 2007

  
**ARDIN H. MARSCHEL**  
**SUPERVISORY PATENT EXAMINER**